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10/589,556	05/16/2007	Kentaro Nakamura	2870-0341PUS1	8157

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EXAMINER

GERIDO, DWAN A

ART UNIT	PAPER NUMBER
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1797

NOTIFICATION DATE	DELIVERY MODE
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06/19/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No.

11/060,775. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-7 recite nearly identical limitations (3 layers of an analysis element) within the device. Claim 1 of application 11/060,775 recites the parameters for mean deviation and irregularity profile of the contact surface whereas the instant claims are silent to a mean deviation/irregularity profile. The instant claims, and the claims of 11/060,775 both recite multilayer analysis element comprising a water permeable porous spreading layer made of non-fibrous film and a water permeable reagent layer (functional later) arranged opposite the spreading layer wherein the porous film is made of organic polymers, specifically polyamide,

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polyethylene, polypropylene, 6-nylon, 6,6-nylon, and polysulfone. Because the materials of the devices are identical, the characteristics of the device (mean deviation/irregularity profile) are read as inherent features of the claimed device.

3. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 2, and 5-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tanaka et al., (US 4,990,457).

9. For claim 1, Tanaka et al., teach a multilayer analysis element comprising a water permeable porous spreading layer made of non-fibrous film and a water permeable reagent layer (functional later) arranged opposite the spreading layer (abstract, column 3 lines 11-17). Tanaka et al., also teach the spreading layer as fibrous or non-fibrous (column 3 lines 24, 25).

Additionally, Tanaka et al., teach various arrangements of the layers including the non-fibrous spreading layer being the outermost layer of the device (column 3 line 52 - column 4 line 7).

The analysis element of Tanaka et al., comprises materials identical to that of the instant application (column 6 lines 26-38), therefore the limitations of bending rupture strength, and tensile percentage represent inherent features of the device.

10. With regards to claims 2, and 5-7, Tanaka et al., teach a multilayer analysis element comprising a porous film of organic polymers, specifically polyamide, polyethylene, polypropylene, 6-nylon, 6,6-nylon, and polysulfone (column 6 lines 26-38).

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11. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al., (US 4,990,457) in view of Hildenbrand et al., (US 4,824,639).

12. With regards to claims 3 and 4, Tanaka et al., do not teach an analysis element having an asymmetry ratio of 2 or more, nor do they teach a symmetry ratio of less than 2.

Hildenbrand et al., teach a multilayer test strip comprising a microporous polymer layer with an asymmetric pore structure that is advantageous because it filters particles based on size. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tanaka et al., in view of Hildenbrand et al., to gain the advantage of utilizing an asymmetric pore structure in order to filter particulates within the sample material based on size. Tanaka et al., in view of Hildenbrand et al., do not recite values for asymmetry or symmetry ratios. The asymmetry and symmetry ratios are being read as an inherent feature of any porous layer as the layer would exhibit both symmetry and/or asymmetry with regards to pores within the layer, and setting values for said ratios is viewed as optimization of known parameters. In addition, the MPEP states that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation (MPEP 2144.05 IIA). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tanaka et al., in view of Hildenbrand et al., in order to control pore size by optimization of the symmetry/asymmetry ratios.

Response to Arguments

13. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection. Applicant has amended independent claim 1 to recite a non-fibrous porous film on the outermost layer of the analytical element. In light of applicant's

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amendment, reference to Nagamoto et al., has been removed. The claims as presented are now rejected over Tanaka et al., which recite a non-fibrous porous layer on the outermost layer of the analytical element which meets the claim limitations.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwan A. Gerido, Ph.D. whose telephone number is (571)270-3714. The examiner can normally be reached on Monday - Friday, 9:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on (571) 272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROBERT J. HILL, JR/
Primary Examiner, Art Unit 1797

DAG